UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
DEBROW, JAMES J

ART UNIT	PAPER NUMBER
2176	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/685,192	MEWHERTER ET AL.
	Examiner	Art Unit	
	JAMES DEBROW	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 June 2011</u>.
2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-22</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-22</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
       1.☐ Certified copies of the priority documents have been received.
       2.☐ Certified copies of the priority documents have been received in Application No. _____.
       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

This action is responsive to communications: the decision set forth by the Board

of Patent Appeals and Interferences (i.e., BPAI) dated 04/01/2011 and the RCEX filed

01 Jun 2011.

Claims 1-22 are pending in this case. Claims 1, 6, and 16 are independent

claims.

Applicant's Response

The examiner notes that the BPAI affirmed all claim rejections in the Decision

dated 04/01/2011. In response to the BPAI's Decision, Applicant filed the response

dated 01 Jun 2011. In the response, Applicant amended claims 1, 6 and 16, and

argued against all rejections previously set forth.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this

application after a decision by the Board of Patent Appeals and Interferences, but

before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or

the commencement of a civil action. Since this application is eligible for continued

examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been

timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution

in this application has been reopened pursuant to 37 CFR 1.114. Applicant's

submission filed on 01 Jun 2011 has been entered.

Specification

The disclosure is objected to because of the following informalities:

- The phrase "important text within in slide further can be extracted" on Page 8

  should be amended to – important text within [[in]]each slide ~~further can be~~ is

  extracted – so that the sentence reads more clearly.

Appropriate correction is required.

Claim Objections

Claim 1 is objected to because of the following informalities:

- The phrase "*programmed both to extract contextual data from a slide from said*

  slide show" in Lines 7-8 should be amended to — programmed [[both]] to extract

  contextual data from a slide [[from]]in said slide show — so that the limitation is

  grammatically correct and reads more clearly.

Claims 17-22 is objected to because of the following informalities:

- In Claim 17, the phrase "*machine readable storage*" in Line 1 should be amended

  to — machine readable storage medium — because that is how the element is

  previously identified (see Claim 16, Line 1). Claims 18-22 have the same

  problem.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 16-22:

In summary, Claim 16 recites a "*machine readable storage medium*" having a "*computer program*" that performs various functions. The Specification fails to expressly limit the recited "*medium*" to a statutory embodiment. Thus, the plain and ordinary meaning of the recited "*medium*" includes signals, carrier waves, etc.

Accordingly, the recited "*machine readable storage medium*" is not a process, a machine, a manufacture or a composition of matter, and Claim 16 fails to recite statutory subject matter as defined in 35 U.S.C. 101.

Claims 17-22 do not further define the recited "*machine readable storage medium*" as being within a statutory process, machine, manufacture or composition of matter.

Accordingly, Claims 17-22 fail to recite statutory subject matter as defined in 35 U.S.C. 101.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claims 1-5:

Claim 1 now recites "*to place a text form of the contextual data in proximity to the raster imagery of the slide show*" (see Lines 10-11). Despite reviewing the Specification of the present invention, the examiner cannot find support for the cited claim limitation. Stated differently, based upon the examiner's review of the Specification, the examiner finds no discussion of placing a "text form" of the contextual data "in proximity to" the raster imagery of the slide show.

Therefore, Applicant is obligated to respond by explaining where in the Specification support for this limitation can be found. See *In re Alton*, 76 F.3d 1168, 1175 [37 USPQ2d 1578] (Fed. Cir. 1996). See *Hyatt v. Doll*, 91 USPQ2d 1865 (Fed. Cir., 2009).

Due at least to their dependency upon Claim 1, Claims 2-5 also recite new

matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-9, 12, 14-19 and 22 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Erol in view of Chakraborty (Pub. No.: 2004/0194035 A1; Filing

Date: Mar. 31, 2000) (hereinafter 'Chakraborty').

In regards to independent claim 1, Erol discloses *a system for converting slide*

show presentations for use within non-presentation applications, the system comprising:

a computing system with at least one processor and memory (0041-0042);

a slide show produced by a slide show presentation application and stored in a

native format (0032-0034; Erol discloses a PowerPoint presentation which may contain

natural or synthetic images, photos, text or lines of text or a combination of thereof.).

a slide show conversion process executing in the memory of the computing

system and configured for coupling to a non-presentation application and *programmed*

both to extract contextual data from a slide from said slide show in its native format, to

convert the slide in said slide show to raster imagery for use in said non-presentation

(0032-0034; 0111; 0118; Erol discloses a PowerPoint presentation which may contain

natural or synthetic images, photos, text or lines of text or a combination of thereof. Erol

also discloses presentation slides can be stored as a sequence of images, e.g. as

JPEGs, BMPs, etc.(raster imagery). Erol further discloses using Optical Character

Recognition (OCR) for extracting text from a PowerPoint file/slide.).

Erol does not expressly disclose *to place a text from of the contextual data in*

proximity to the raster imagery of the slide show.

Chakraborty teaches *place a text from of the contextual data in proximity to the*

raster imagery of the slide show (0021; 0024; 0037; 0055; Chakraborty teaches placing

extracted text in a partial AIU file and placing extracted non-text in a partial AIU file, then

combining both files to create a complete AIU file that represent all the extracted form

information for the text and non-text portion of the file. Therefore the Examiner

concludes it would have been obvious to one of ordinary skill in the art to modify

Chakraborty teaching for the benefit of placing a text from of the contextual data in

proximity to the raster imagery of the slide show.).

Therefore at the time of the invention, it would have been obvious to a person of

ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an

information extraction process for extracting form information associated with text

portions and/or non-text portion within an electronic document (0017).

In regards to dependent claim 2, Erol does not expressly disclose *the system of claim 1, wherein said contextual data comprises a slide title for each one of said associated slides.*

However Chakraborty teaches *contextual data comprises a slide title for each one of said associated slides* (0020; 0029; 0032; 0036; Chakraborty teaches extracting text and non-text (i.e., images) information from an electronic document. Chakraborty further teaches extracting titles and fields along with their coordinates and their styles.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

In regards to dependent claim 3, Erol does not expressly disclose *the system of claim 1, wherein said contextual data comprises important text associated with each one of said associated slides.*

However Chakraborty teaches *contextual data comprises important text associated with each one of said associated slides* (0020; 0022; 0024; Chakraborty teaches extracting important form information within portions that has been recognized by the system, i.e. lines as lines, text as text, etc., as well as form information that lies within images.).

Therefore at the time of the invention, it would have been obvious to a person of

ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an

information extraction process for extracting form information associated with text

portions and/or non-text portion within an electronic document (0017).

In regards to dependent claim 4, Erol does not expressly disclose *the system*

of claim 1, wherein said slide show conversion process further comprises programming

for generating a markup language document and for disposing said contextual data and

said raster imagery within said markup language document.

However Chakraborty teaches *generating a markup language document and for*

disposing said contextual data and said raster imagery within said markup language

document (0010; 0021; 0056; Chakraborty teaches the extracted information is stored

as an XML (extensible markup language) file that follows a predefined DTD (document

type definition. Thus Chakraborty teaches disposing said contextual data and said

raster imagery within said markup language document.).

Therefore at the time of the invention, it would have been obvious to a person of

ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing

an information extraction process for extracting form information associated with text

portions and/or non-text portion within an electronic document (0017).

In regards to dependent claim 5, Erol disclose *the system of claim 1, wherein*

said slide show conversion process further comprises programming for reducing said

raster imagery to a size suitable for display in a pervasive device (0041; Erol discloses

user interface output devices that in intended to include all possible types of devices

and ways to output information from data processing system. Thus Erol suggest

reducing said raster imagery to a size suitable for display in a pervasive device.).

In regards to independent Claims 6 and 16, Erol discloses *a slide show*

presentation produced by a slide show presentation application.

converting said first slide with said slide title into a raster image (0032-0034;

0111; 0118; Erol discloses a PowerPoint presentation which may contain natural or

synthetic images, photos, text or lines of text or a combination of thereof. Erol also

discloses presentation slides can be stored as a sequence of images, e.g. as JPEGs,

BMPs, etc.(raster imagery).

Erol does not expressly disclose *extracting a slide title for a first slide in the slide*

show presentation produced by a slide presentation application executing in the

memory of the computer;

disposing both said slide title and said raster image in a markup language

document;

repeating said extracting, converting and disposing steps for a selected group of

other slides in the slide show presentation;

Chakraborty teaches *extracting a slide title for a first slide in the slide show*

presentation produced by a slide presentation application executing in the memory of

the computer (0020; 0029; 0032; 0036; Chakraborty disclose extracting text and non-text (i.e., images) information from an electronic document. Chakraborty further disclose extracting titles and fields along with their coordinates and their styles.).

disposing both said slide title and said raster image in a markup language document (0010; 0020; 0021; 0029; 0032; 0036; 0056; Chakraborty disclose extracting text and non-text (i.e., images) information from an electronic document. Chakraborty further disclose extracting titles and fields along with their coordinates and their styles Chakraborty disclose the extracted information is stored as an XML (extensible markup language) file that follows a predefined DTD (document type definition.).

repeating said extracting, converting and disposing steps for a selected group of other slides in the slide show presentation (It would have been obvious to one of ordinary skill in the art that the steps of extracting, converting and disposing would be repeated for all selected group of slides within the slide show presentation.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

In regards to dependent claims 7 and 17, Erol does not expressly disclose *further extracting important text from said first slide.*

annotating said raster image of said first slide in said markup language document with said extracted important text.

further repeating said repeating, further extracting and annotating steps for a selected group of other slides in the slide show presentation.

Chakraborty teaches *further extracting important text from said first slide* (0020; 0029; 0032; 0036; Chakraborty teaches extracting text and non-text (i.e., images) information from an electronic document. Chakraborty further disclose extracting titles and fields along with their coordinates and their styles.).

annotating said raster image of said first slide in said markup language document with said extracted important text (0010; 0037; Chakraborty disclose XML files which are referred to as Anchorable Information Unit (AIU) files. Chakraborty disclose combining a partial AIU file that contains extracted form information with another partial AIU file that contains extracted form information for non-text (images) portions of the input file. Therefore Chakraborty disclose annotating said raster image of said first slide in said markup language document with said extracted important text.).

further repeating said repeating, further extracting and annotating steps for a selected group of other slides in the slide show presentation (It would have been obvious to one of ordinary skill in the art that the steps of extracting, and annotating would be repeated for all selected group of slides within the slide show presentation.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

In regards to dependent claims 8 and 18, Erol discloses *wherein said further extracting step comprises the step of further extracting text having formatting characteristics within said first slide which emphasizes said text* (0031; 0112; 0116; Erol teaches extracting text having formatting characteristics such as color and font size.).

In regards to dependent claims 9 and 19, Erol discloses *wherein said formatting characteristics comprise a point size which exceeds a threshold value* (0091; 0112; 0116; Erol teaches the formulation for threshold selection includes a constant typically based the amount and size of the text in an image. Thus Erol teach/suggest the concept or technique of formatting characteristics comprise a point size which exceeds a threshold value.).

In regards to dependent claim 12, Erol does not expressly disclose *the method of claim 6, further comprising the step of processing said markup language document in a non-presentation application.*

Chakraborty teaches *the method of claim 6, further comprising the step of processing said markup language document in a non-presentation application* (0028; 0078).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

In regards to dependent claim 14, Erol does not expressly disclose *the method of claim 6, further comprising the step of performing each of said extracting, disposing, converting and repeating steps in externally to a slide show presentation application which produced the slide show presentation.*

Chakraborty teaches *the method of claim 6, further comprising the step of performing each of said extracting, disposing, converting and repeating steps in externally to a slide show presentation application which produced the slide show presentation* (0020-0025; Chakraborty disclose the steps of extracting, disposing, converting text and non-text formed information.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

In regards to dependent claims 15 and 22, Erol discloses *reducing said raster image to a size suitable for display in a pervasive device* (0041; Erol discloses user interface output devices that in intended to include all possible types of devices and ways to output information from data processing system. Thus Erol suggest reducing said raster imagery to a size suitable for display in a pervasive device.).

Erol does not expressly disclose *rendering said slide title.*

Chakraborty disclose *rendering said slide title* (0020; 0029; 0032; 0036; Chakraborty discloses extracting text and non-text (i.e., images) information from an electronic document. Chakraborty further discloses extracting titles and fields along with their coordinates and their styles.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

NOTE

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the reference should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See MPEP 2123.

Claims 10, 11, 13, 20 and 21 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Erol in view of Chakraborty, further in view of Chatterjee et al.

(Patent No.: US 7,162,691 B1; Filing Date: Feb. 1, 2000) (hereinafter 'Chatterjee').

In regards to dependent claims 10 and 20, Erol in view of Chakraborty does

not expressly disclose *wherein said annotating step comprises the step of generating an*

ALT tag with said important text in association with said raster image in said markup

language document.

However Chatterjee teaches *generating an ALT tag with said important text in*

association with said raster image in said markup language document (col. 2, lines 30-

37; Chatterjee teaches XML documents may contain markup tags which identify non-

text data, such as image, audio or video data, or program files. Therefore, at the time of

the invention it would have been obvious to one of ordinary skill in the art to provide a

markup language document containing an ALT tag with said important text in

association with said raster image.).

Therefore at the time of the invention, it would have been obvious to a person of

ordinary skill in the art to combine Chatterjee with Erol in view of Chakraborty for the

benefit of providing markup language documents containing markup tags which identify

non-text data, such as image, audio or video data, or program files (col. 2, lines 30-

37).).

In regards to dependent claims 11 and 21, Erol in view of Chakraborty does

not expressly disclose *wherein said generating step further comprises the step of*

formatting said ALT tag with additional inline indicators for facilitating an audible

playback of said important text in a non-presentation application.

However Chatterjee teaches *the step of formatting said ALT tag with additional*

inline indicators for facilitating an audible playback of said important text in a non-

presentation application (col. 2, lines 30-37; col. 4, lines 51-62; Chatterjee teaches XML

documents may contain markup tags which identify non-text data, such as image, audio

or video data, or program files.).

Therefore at the time of the invention, it would have been obvious to a person of

ordinary skill in the art to combine Chatterjee with Erol in view of Chakraborty for the

benefit of providing markup language documents containing markup tags which identify

non-text data, such as image, audio or video data, or program files (col. 2, lines 30-

37).).

In regards to dependent claim 13, Erol in view of Chakraborty does not

expressly disclose *the method of claim 12, wherein said processing step comprises the*

step of generating an agenda with each slide title for each raster image in said markup

language document. Chakraborty disclose extracting text and non-text (i.e., images)

information from an electronic document. Chakraborty further discloses extracting titles

and fields along with their coordinates and their styles (0020; 0029; 0032; 0036).

Chatterjee teaches *wherein said processing step comprises the step of generating an agenda with each slide title for each raster image in said markup language document* (col. 2, lines 30-37; col. 4, lines 51-62; Chatterjee teaches XML documents may contain markup tags which identify non-text data, such as image, audio or video data, or program files. I t would have been obvious to one of ordinary skill in the art to modify Chakraborty's teaching with Chatterjee's teaching of markup tags for the benefit of generating an agenda with each slide title for each raster image in said markup language document.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chatterjee with Erol in view of Chakraborty for the benefit of providing markup language documents containing markup tags which identify non-text data, such as image, audio or video data, or program files (col. 2, lines 30-37).).

NOTE

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the reference should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See, MPEP 2123.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new

ground(s) of rejection.

Previous 35 USC § 101 claim rejections are withdrawn.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to James J. Debrow whose telephone number is 571-272-

5768. The examiner can normally be reached on 8:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

/James J Debrow/
Examiner, Art Unit 2176

/Doug Hutton/
Supervisory Patent Examiner, Art Unit 2176